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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/411,322	10/04/99	MONJU T	104472

IM22/0411

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EXAMINER	
SHEWAREGED, B	
ART UNIT	**PAPER NUMBER**
1774	3

DATE MAILED: 04/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary	Application No.	Applicant(s)	
	09/411,322	MONJU ET AL.	
	Examiner	Art Unit	
	Betelhem Shewareged	1774	

-- Th MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 1999* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) *13-16* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-12, drawn to thermal transfer, classified in class 428, subclass 195.

   II. Claims 13-16, drawn to method of making, classified in class 427, subclass 1+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, (e.g., providing a solvent-resistant film and a film having an ink, laminating the solvent-resistant film onto a support layer and followed by laminating the film having an ink onto the laminated solvent-resistant layer).

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Jacob Dougty on 03/20/2001 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-12. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 13-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

6. Claim 12 is objected to because of the following informalities: claim 12 is the same as claim 11. Claim 12 does not further limit claim 4 any more than claim 11 does. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. In claim 1, it is not clear if the ketone resin in the solvent-resistant layer or the ink layer. Clarification is kindly requested.

b. In claim 11, lubricant is misspelled as "lbricant". Appropriate correction is requested.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sugita et al. (US 6,174,607) in view of Kitamura et al. (US 5,279,884).

Sugita discloses a thermal transfer recording medium having a support layer, an ink layer and a layer that is used as a release layer between the support and the ink layer. (Col. 3 lines 30-59). A heat-resistant lubricant layer is formed on the substrate opposite to the side on which the ink layer is formed. (Col. 4 line 43). The layer that is used as a release layer is made of polyethylene wax or polyester resin. Even though Sugita does not teach a combination of polyethylene wax and polyester resin, it would be obvious to combine both polyethylene wax and polyester resin so as to provide a layer having the same effect. *In re Crockett,* 126 USPQ 186, It is obvious to combine separately taught prior art ingredients which perform the same function; it is logical that they would produce the same effect and supplemental each other.

Sugita teaches the addition of other resins into the ink layer. It would have been obvious to add a ketone resin, because the use of an ink composition having a ketone resin and polyethylene wax is conventional in the thermal transfer recording medium art. (See US 5, 279,884, col. 9, line 2-20).

As to claims 2 and 3, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to vary the content of the polyethylene wax so as to provide a desirable final product. *In re Aller,* 105 USPQ 233, Experimental modification of prior art in order to optimize operating conditions fails to render claims patentable in

the absence of unexpected result. Amount of polyethylene wax in a layer is conventional concern in the art, for it provides a layer with desired properties.

As to claims 5, 7 and 9, at the time of the invention, it would have been obvious to a person of ordinary skill in the art to duplicate the layer that is used as a release layer, since it has been held that a mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.,* 193 USPQ 8.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 703-305-0389. The examiner can normally be reached on Tue.-Thur. 7:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

Bruce Hess

BRUCE H. HESS
PRIMARY EXAMINER

BS BS
April 8, 2001.